

Envision
9-8-03
15/
Electric
Attorney Docket No.: 56492 (71699)

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: J. H. Anderson, *et al*
U.S. Serial No.: 10/091,742
Filed: March 5, 2002
Entitled: SIMULATION SYSTEM FOR IMAGE-
GUIDED MEDICAL PROCEDURES

Group: 3714

Examiner: Ashburn,
Stephen L.
Conf. No. 8190

RECEIVED
SEP 02 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TECHNOLOGY CENTER R3700

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service, in an envelope with sufficient postage as first class mail addressed to, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 25, 2003.

By:

Helen Murray Tarbi
Helen Murray Tarbi

Sir/Madam:

RESPONSE TO RESTRICTION REQUIREMENT

Applicants respond as follows to the Restriction Requirement as set forth in the Office Action dated July 25, 2003.

In the Office Action, the Examiner divided the claims into the following groups requiring that one group be elected for further examination.

Group I including claims 1-37, 44, 46, 47-63, 74 and 75 drawn to a system characterized by the Examiner as "for providing tracking simulated devices".

Group II including claims 38-43 and 64 drawn to a system characterized by the Examiner as "for simulating a syringe device."

Group III including claims 45 and 65-71 drawn to a system characterized by the Examiner as "simulating a balloon-angioplasty device."

Group IV including claims 72 and 73 drawn to a system characterized by the Examiner as for "simulating a coil embolization device."

Applicants hereby elect Group I, which presently includes claims 1-37, 44, 46, 47-63, 74 and 75, with traverse. The election is made solely to comply with the Office Action and should not be construed as a surrender of any subject matter in the application. The right to file divisional applications on the non-elected claims is reserved.

Applicants respectfully request reconsideration of the Restriction Requirement as set out in the Office Action as it is improperly applied.

The Examiner has applied the Restriction Requirement after having already examined all of the claims with the exception of newly added claims 74 and 75 presented in Applicants' Response to the First Office Action filed January 2, 2003. The Restriction Requirement made no mention of Applicants' Response to the previous Office Action or why the Requirement was applied now and not previously when the claims presented in the response included the same subject matter of the original claims already examined. In a telephonic interview with the Examiner on July 31, 2003, the Examiner asserted that the Applicants' amendments necessitated Requirement by adding additional limitations to the claims.

Applicants submit that the Requirement is improper for the following grounds.

Clearly, Applicants amendment did not necessitate applying the Restriction Requirement to claims 64, 72 and 73 as these claims were not amended in Applicants' previous Response.

Accordingly, Applicants submit that the Requirement with respect to these claims is improper and that minimally, claims 64, 72 and 73 should be rejoined with the Group I claims.

Additionally, none of the amendments made to the remainder of the claims changed the invention represented by the claims. The Examiner has presented no arguments that Applicants presented new and distinct inventions by their amendments from those originally claimed (and indeed would not be able to). By the Examiner's line of reasoning, *any* amendment to claims would necessitate a new restriction requirement, delaying pendency of applications to an unreasonable degree.

There is no additional burden imposed on the Examiner beyond that required by him to reasonably and fairly evaluate the claims presented in Applicants' previously filed Response, considering each limitation of the claims, in light of the prior art as he would be required to *with any response*.

Applicants note that the Examiner has agreed that the next Office Action should not be final.

As an additional matter, Applicants request that in the next Office Action, that the Examiner cite by specific page and line number (rather entire columns of text) where he believes a feature of the invention is disclosed as in the previous Office Action many of the referenced sections did not appear to support the assertions being made by the Examiner.

CONCLUSION

Applicants submit that all claims are allowable as written and respectfully request early favorable action by the Examiner.

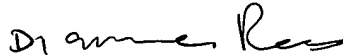
Although it is not believed that any fee is required to consider this submission, the

Attorney Docket No.: 56492 (718-9)
U.S.S.N. 10/091,742
Filed: March 5, 2002
Response to Restriction Requirement
Page 4 of 4

Examiner is hereby authorized to charge our deposit account 04-1105 should any fee be deemed necessary.

Respectfully submitted,

Date: August 25, 2003



Dianne M. Rees, Ph.D.
(Reg. No. 45,281)
EDWARDS & ANGELL, LLP
Intellectual Property Group
P.O. Box 9169
Boston, MA 02209

Telephone: 617-439-4444
Customer No. 21874

BOS2_345845.1